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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,915	11/16/2000	Toshiyuki Moritsu	ASA-945	2987/

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EXAMINER

WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 11/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/712,915

Applicant(s)

MORITSU ET AL.

Examiner

Jalatee Worjloh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-21 is/are allowed.
- 6) ☒ Claim(s) 1-14 and 22-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This Office Action is responsive to the amendment filed on September 15, 2003, in which claims 1-10, 12-17, 19-23 and 26 were amended and claim 11 canceled.

Response to Arguments

2. Applicant's arguments filed September 15, 2003 have been fully considered but they are not persuasive.

3. Referring to claims 1, 2, 3, and 6, Applicants argue that Walker et al. do not disclose or suggest checking in the future whether or not the contents of a contract are consistent with its description made before entering into the contract or contract data having descriptions specifying data or question and answers.

However, the step of "checking in the future whether or not the contents of a contract are consistent with its description made before entering into the contract" is not taught in claims 1, 2 or 3; therefore, this argument will not be considered.

As per the argument that Walker et al. do not disclose "contract data having descriptions specifying data or question and answers.", notice, claim 1 recites "if said contract is made, generating, in both or either system of said concerned parties, contract data containing said description data stored in at least one system of said concerned parties and said third party or description specifying data for specifying said description content and a contract content", which implies that either the contract data containing said description data stored of said concerned parties and third party is generated or description specifying data for specifying said description

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content and a contract content is included in the generated contract data (not both). This, Walker et al. disclose contract data containing said description data stored in at least one system of said concerned parties and said third party (see col. 19, lines 40-60).

4. Applicants' arguments with respect to claim 6 have been considered but are moot in view of the new ground(s) of rejection.

5. Applicant's arguments with respect to Simon have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 4 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The steps must be clearly and positively specified; that is, it must be organized and correlated in such a manner as to present a complete operative method. Claim 4 includes two entitles a covenantor and covenantee; the covenantor receives "a question or request for said commodity or service" from a covenantee then the covenantor outputs a response to the covenantee. Next, claim 4 recites "if the system of **said covenantor** obtains the response with an electronic signature of said covenantee added thereto from **the system of said covenantor**, concluding in the system of said covenantor, an electronic contract between said covenantor and said covenantee about said contract". Notice, there is no previous response being sent from the covenantee; the only response being sent is that of the covenantor. Is this the same response that

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the covenanter sends to the covenantee in the first step or a new response? The wording of this limitation is confusing; please revise for clarity.

8. Claim 13 recites the limitation "said data string" in line 18. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 7- 10, 12-14 and 24-26 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No.6061792 to Simon.

Referring to claim 7, Simon discloses creating a hash value of description data containing a description content about said commodity or service having been transferred between the concerned parties before concluding said contract and data proving that both or either the concerned parties has created or accepted said description content (see col. 5, lines 1-67), inserting said hash value in contract data containing said contract content therein and storing said contact data containing said description content and said hash value in at least one system of the concerned parties and said third party (see col.7, lines 1-10).

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Referring to claims 8-10, Simon discloses a processing unit (i.e. consumer PC) for creating data string determined with regard to description data containing a description content about a commodity or service and data for providing that both or either of the concerned parties has created or accepted said description content, said description data having been transferred between the concerned parties about said contract before concluding said contract, another processing unit (i.e. merchant PC) making contract have correspondence relationships with said description data by using said data string, said contract data including said contract content (see col. 5, lines 1-67; col. 7, lines 55-57); wherein said data string is a hash value of said description data; wherein said data string is said description data (see col. 4, lines 20-24; col. 5, lines 36-39).

Referring to claim 12, Simon discloses another processing unit for making a description processing program for describing said contract content on an electronic contract document about said contract have correspondence relationships with said contract data (see col. 4, lines 9-14).

Referring to claim 13, Simon discloses a storage unit (see col. 3, lines 55-57), stores description data containing a description content about said commodity or service having been transferred between concerned parties about said contract before concluding said contract said description data being created in both or either of system of the concerned parties (see col. 2, lines 35-47), if said contract is concluded, stores contract data containing said contract content, said contract data being created in both or either of system of the concerned parties (see col. 7, lines 1-10); and both or either of the systems of the concerned parties making said description data and said contract data have correspondence relationships to each other by using a data string (see col. 5, lines 1-49).

Referring to claim 14, Simon discloses a program sending device comprising (see col. 3, lines 25-30) a processor creating data string determined with regard to description data containing a description content about a commodity or service having been transferred between concerned parties about a contract before concluding said contract and data for proving that both or either of the concerned parties has created or accepted said description content (see col. 5, lines 1-67), and a process for making contract data containing a contract content about provision of said commodity or service and said description data have correspondence relationships to each other by using data string, and for storing said contract data and said description data thus having correspondence relationships in a storage unit (see col. 7, lines 1-10).

Referring to claim 24, Simon discloses obtaining a describing program for enabling concerned parties with said contract to describe a contract content on an electronic contract document or specifying data for specifying said describing program, generating contract data containing said describing program or said specifying data and writing an electronic signature of both or either of said concerned parties on said contract data (see col. 4, lines 9-19; col. 2, lines 36-45; col. 7, lines 1-7).

Referring to claim 25, Simon discloses a processing unit for creating a data string determined with regard to a describing program for describing a content of said contract on an electronic contract document, another processing unit for making contract data obtained by describing said contract content on said electronic contract document and said describing program have correspondence relationships by using said data string col. 5, lines 1-67; col. 7, lines 55-57).

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Referring to claim 26, Simon discloses a recording medium (see col. 4, lines 9-14) comprising a contract content describing process for describing a content of said contract on an electronic contract document, a contract data generating process for generating contract data from an electronic contract document in which said contract content is described (see col. 2, lines 36-45), a program inserting process for inserting a data string determined with regard to, a contract data signing process for adding a signature of at least one of concerned parties with said contract to contract data containing said data string (see col. 4, lines 20-24; col. 7, lines 1-10).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5794207 to Walker et al.

Walker et al. disclose storing, in at least one system of one concerned party on said contract, other concerned party on said contract and a third party (i.e. "central controller"), description data containing a description content (i.e. "CPO data") presented from said one concerned party to said other concerned party (see col. 8, lines 41-58; col. 17, lines 48-52; col. 18, lines 34-35) and electronic signature on said description content of both or either of said concerned parties before making said contract (see col. 8, lines 7,8 and col. 13, lines 1-9). Note. The buyer submits a CPO with a buyer ID attached, the examiner presumes that the buyer ID

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made be any authenticating data stored in the buyer's database including an electronic signature (see col. 13, lines 1-9). Although, it is not explicitly stated that the database includes an electronic signature it is inferred; that is, the database maintains authenticating data relating to buyer's name, address, e-mail ad public/private key information etc. (thus digital signature may be stored). Also, Walker et al. disclose if said contract is made generating in both or either system of said concerned parties, contract data (i.e. "signed CPO data with seller response") containing said description data (i.e. "CPO data") stored in at least one of said concerned parties and said third party (i.e. "central controller") or description specifying data for specifying said description content and a contract content; executing, in the respective systems of the concerned parties, respective electronic signatures on said contract data of said concerned parties; and storing, in at least one system of said concerned parties and said third party, said contract data containing the electronic signatures of said concerned parties (see col. 19, lines 40-60). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to develop a method for making electronic contract including description data and electronic signatures. One of ordinary skill in the art would have been motivated to do this because it allow a seller who meets the terms of the purchase offer to bind the buyer to accept the seller's fulfillment of that offer (see col. 7, lines 35-38) and provides a trusted third-party whose decision regarding the fulfillment, adequacy or interpretation of any aspect of the process shall be binding on the parties (see col. 7, lines 43-46).

Referring to claims 2 and 3, Walker et al. disclose receiving a question or request for said commodity or service from a system of a covenantee who intends to conclude said contract through a network (see col. 8, lines 44-58), adding to a response to said question or request, in a

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system of said covenanter covenanter's proof that said covenanter's proof that said covenanter created said response, sending said response containing said covenanter's proof from the system of said covenanter to said covenantee through the network, storing said response containing said covenanter's proof in at least one system of said covenanter, said covenantee, and a third party (see col. 19, lines 14-67; col. 20, lines 1-4), if said contract is concluded between said covenanter and said covenantee, creating in at least one system of said covenanter, said covenantee and said third party, an electronic contract bound to said response containing said covenanter's proof, wherein said response containing said covenanter's proof includes a covenantee's proof that said covenantee has agreed with said response (see col. 13, lines 39-44). Note. The buyer creates a conditional purchase offer (CPO) that includes the buyer's ID and name. When the seller accepts the CPO, a contract is generated including the buyer's ID and name (i.e. "covenantee's proof"). Also, Walker disclose storing, in at least one system of said covenanter, said covenantee and said third party said electronic contract bound to said response containing said covenanter's proof (see col. 19, lines 40-60).

13. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6061792 to Simon in view of US Patent No. 6253322 to Susaki et al.

Simon discloses if a question or request for said commodity or service is received from a covenantee who intends to conclude said contract, outputting a response to said question or request to a system of said covenantee from a system of said covenanter, obtaining the response with an electronic signature of said covenantee added thereto from said covenanter, concluding an electronic contract between said covenantee about said contract (see col. 2, lines 35-45; col. 7, lines 16-20). Simon does not expressly disclose making, in the system of said covenanter, said

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electronic contract document have correspondence relationships to the response with said covenantee's electronic signature added thereto by using a data string determined with regard to said response with said covenantee's electronic signature added thereto; and sending said electronic contact document from the system of said covenanter to the system of said covenantee. Susaki et al. disclose making, in the system of said covenanter, said electronic contract document have correspondence relationships to the response with said covenantee's electronic signature added thereto by using a data string determined with regard to said response with said covenantee's electronic signature added thereto (see col. 15, lines 8-40); and sending said electronic contact document from the system of said covenanter to the system of said covenantee (see abstract, lines 9-22). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Simon to include the steps of making, in the system of said covenanter, said electronic contract document have correspondence relationships to the response with said covenantee's electronic signature added thereto by using a data string determined with regard to said response with said covenantee's electronic signature added thereto; and sending said electronic contact document from the system of said covenanter to the system of said covenantee. One of ordinary skill in the art would have been motivated to do this because adding the covenantee's electronic signature to the data string provides additional security.

Referring to claim 5, Simon discloses adding, in the system of said covenanter, an electronic signature of said covenanter to the response to be outputted to the system of said covenantee (see col. 7, lines 1-8).

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14. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. in view of Susaki et al.

Walker et al. disclose sending a question or request for provision of said commodity or service to a provider of said commodity or service through a network, receiving a response to said question or request from said provider through the network (see col. 8, lines 44-61; col. 14, lines 8-11), adding an electronic signature of said person who accepts said commodity or service to said response and then sending said response to said provider through the network, storing said response with the electronic signature of said person who accepts said commodity or service added thereto in at least one of storage units of said provider, said person who accepts said commodity or service and a third party, and if a contract for provision of said commodity or service is concluded between said provider and said person who accepts said commodity or service, storing an electronic contract document said response with the electronic signature of said person added thereto thus having correspondence relationships in at least one system of said provider, said person and said third party (see col. 19, lines 14-67; col. 20, lines 1-4). Walker et al. do not expressly disclose making an electronic contract document on said contract have correspondence relationships to said response with an electronic signature of said person added thereto by using a data string determined with regard to said response with said person's electronic signature added thereto. Susaki et al. disclose making an electronic contract document on said contract have correspondence relationships to said response with an electronic signature of said person added thereto by using a data string determined with regard to said response with said person's electronic signature added thereto (see col. 15, lines 8-40). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art

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to modify the method disclose by Walker et al. to include the step of making an electronic contract document on said contract have correspondence relationships to said response with an electronic signature of said person added thereto by using a data string determined with regard to said response with said person's electronic signature added thereto. One of ordinary skill in the art would have been motivated to do this because it provides additional security.

15. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simon. Referring to claim 22, Simon discloses determining if an electronic signature contained said retrieved description data is correct and verifying that said retrieved description content is presented from one of said concerned parties to the other when the contract between said concerned parties is being transferred (see col. 4, lines 20-24; col. 6, lines 61-67; col. 7, lines 16-20). As for retrieving a description content about said contract content from a storage unit which manages description data and contract data containing contract contents, said description data containing description contents about said commodity or service having been transferred between the concerned parties before concluding said contract and data for proving that both or either of the concerned parties has created or accepted said description said description data, said description data and contract data having correspondence relationships to each other by using a data string determined with regard to said description data this is an inherent step. That is, Simon discloses storing a valid contract and printing the contract in case of dispute (see col. 7, lines 7-20), before doing this the contract, which comprises the description, content must first be retrieved from the storage unit. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to develop a method for verifying a content of a contract including retrieving description content an electronic signature contained in a retrieved

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description data is correct. One of ordinary skill in the art would have been motivated to do this because it ensures that the contract data is accurate; thus, preventing fraud.

Referring to claim 23, Simon discloses the hash value of said description data is compared with a value derived by digitizing said electronic signature, for determining if said electronic signature is correct (see col. 6, lines 9-22, 61-67). Note. The message signature is authenticated which implies that the contract of the description data and its hash value was also authenticate; hence compared.

Allowable Subject Matter

16. Claims 15-21 are allowed.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306, 703-746-9443 for Non-Official/Draft.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450***

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, V.A., Seventh floor receptionist.

November 17, 2003


**JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600**